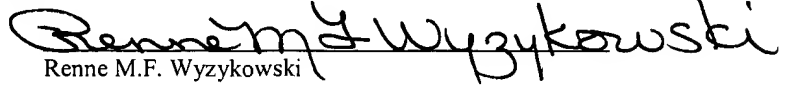




PATENT

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Renne M.F. Wyzykowski

Applicant : Michael L. Obradovich Confirmation No. 9904
Application No. : 09/838,491
Filed : April 19, 2001
Title : CENTRALIZED CONTROL AND MANAGEMENT SYSTEM FOR
AUTOMOBILES
Grp./Div. : 2173
Examiner : Cao H. Nguyen
Customer No. : 56317
Docket No. : 56019/C685

**SUBMISSION OF APPELLANT'S BRIEF
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
June 21, 2006

Commissioner:


Enclosed for filing is the Appellant's BRIEF for this application.

- _____ An extension of time to file Appellant's Brief is requested, and a Petition for Extension of Time and the applicable fee are enclosed.
- X Our check for \$250.00 to cover the fee for the appeal brief is enclosed.
- X An oral hearing of the appeal is requested, and our check for \$500.00, the fee for the oral hearing, is enclosed.

The Commissioner is hereby authorized to charge any further fees under 37 CFR 1.16 and 1.17 which may be required by this paper to Deposit Account No. 03-1728. Please show our docket number with any charge or credit to our Deposit Account. **A copy of this letter is enclosed.**

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 
Daniel M. Cavanagh, Reg. No. 41,661
Telephone: 626/795-9900



AF zhw

PATENT

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APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Post Office Box 7068
Pasadena, CA 91109-7068
June 21, 2006

Commissioner:

This is an appeal to the Board of Patent Appeals and Interferences from the Final Rejection, dated December 29, 2005, in which Claims 21-29, 41-48, and 59-62 of the above-referenced application stand rejected.

06/27/2006 LWONDIM1 00000054 09838491

01 FC:2403 500.00 OP
02 FC:2402 250.00 OP



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APPENDIX A	Claims on Appeal.
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EXHIBIT 2	<i>Ex parte Obiaya</i> , 227 USPQ 58 (Bd. Pat. App & Inter. 1985)



APPELLANT'S BRIEF ON APPEAL
Michael L. Obradovich
Serial No. 09/838,491
Filed June 21, 2006

Case C685:56019

I. REAL PARTY IN INTEREST

The real party in interest is AMERICAN CALCAR INC.

II. RELATED APPEALS AND INTERFERENCES

There are no related Appeals and/or Interferences.

III. STATUS OF CLAIMS

Claims 21-29, 41-48, and 59-62 are pending in this application. These claims which stand finally rejected are the subject of this appeal. A copy of these Claims on Appeal are appended hereto (see Appendix A).

VI. STATUS OF AMENDMENTS

A Final Office Action was mailed on December 29, 2005 in which the Examiner has twice rejected applicant's claims as being obvious over the same two references. An advisory Action was mailed on April 13, 2006, denying entry of applicant's Amendment After Final Action which would otherwise improve the form of the claims, but which is not necessary to overcome the obviousness rejection.

V. SUMMARY OF THE INVENTION

The Problem Solved by the Invention

The claimed invention is directed to a technique for providing, in a vehicle, information from information sources outside the vehicle which are geographically dependent. In an illustrative embodiment, such information sources may include radio stations which broadcast news, talk shows, music, etc. However, the geographic coverage of a radio station may be limited. As the vehicle travels beyond the coverage, the broadcast from the station may become too weak to receive. Thus, for example, a vehicle user who travels from one geographic area to

another finds it inconvenient when entering a new geographic area to look for radio stations which provide relatively good reception. In accordance with the invention, radio stations are grouped according to geographic areas. The radio stations in each group provide relatively good reception in the geographic area associated with the group. In implementation, representations of the radio stations (e.g., radio station frequencies) are stored, in a memory of the inventive system, in association with geographic areas. These geographic areas may be identified by their global positioning system (GPS) coordinates. The inventive system provides a group of representations of radio stations on a display for selection which are associated with the geographic area where the vehicle is. The inventive system determines whether the current location of the vehicle is within a predetermined range of a second geographic area. If it is, a second group of representations of the radio stations associated with the second geographic area are retrieved from the memory and provided on the display for selection, instead. *See* page 42, line 10 *et seq.* of the specification, Fig. 18.

Brief Overview of Appellant's Claims

Claims 21-29, 41-48 and 59-62 are drawn to a system and method for facilitating a vehicle user's selection of an information source which is geographically dependent. The inventive system provides, e.g., on a display, a set of indicators indicating a group of information sources which is associated with a location. Each indicator is selectable to receive signals from the information source indicated by the indicator. The inventive system determines whether the vehicle is within a predetermined distance of a second location. If it is, a second set of indicators indicating a second group of information sources associated with the second location are provided.

VI. ISSUES PRESENTED FOR REVIEW

Whether claims 21-29, 41-48, and 59-62 are unpatentable under 35 U.S.C. 103 as being obvious over U.S. Patent No. 5,732,338 issued March 24, 1998 to Schwob (hereinafter

“Schwob”) in view of R. Jurgen, “Broadcasting with Digital Audio,” *IEEE Spectrum*, March 1996, pp. 52-59 (hereinafter “Jurgen”).

VII. GROUPING OF CLAIMS

It is respectfully submitted that system claims 21-29, 59 and 60, and corresponding method claims 41-48, 61 and 62 are individually patentable over the cited art. All claims are to be considered separately for purposes of this appeal.

VIII. ARGUMENTS

The Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness Utilizing Schwob in View of Jurgen

Schwob discloses a radio receiver capable of receiving audio content from a broadcasting station, and data from a VHF/FM subcarrier. The data is used to update a database in the receiver which is used to identify received broadcasting stations, and search for stations according to user-chosen attributes and other data. The database update may be automatic wherein the receiver upon being turned on is immediately tuned to the closest VHF/FM station (the “data provider”). The update may be semi-automatic wherein an internal clock is used to prompt the receiver to tune to the data provider at specified times. The update may be manual wherein the user is required to press a dedicated key (220) on the front panel. Col. 24, line 27 *et seq.*, Abstract of Schwob.

Jurgen describes a technique for digital audio broadcast (DAB), and discloses the following two scenarios in which such a technique is applied:

[A] DAB car radio will monitor signal strengths and switch automatically from a fading signal to a stronger one. If the driver selects the broadcasting station CBS, for example, the radio will make use of CBS signals from any transmitter along that broadcaster’s network, regardless of the exact frequency in the coverage area the driver happens to be in.

If a signal from one transmitter disappears suddenly, as

is common with digital signals, the radio will then retune itself ... to receive signals from another CBS transmitter down the pike....

In another scenario, a driver might be more concerned about the type of programming he receives, rather than maintaining “brand loyalty” to one network. If the driver selects “Oldies,” the radio will automatically switch from one station broadcasting that type of programming to another doing the same. Using this feature, known as a single frequency network (SFN), all the transmitters in a network will operate on the same frequency and broadcast the same programs.

Jurgen at page 54 (emphasis added).

The Examiner rejected claims 21-29, 41-48, and 59-62 under 35 U.S.C. 103 (a) as being allegedly obvious over Schwob in view of Jurgen. These rejections are improper for at least two following reasons:

- 1) There would have been no motivation to combine the cited references to solve the problem which the claimed invention was set out to solve.
- 2) The combination of the cited references still does not produce the claimed invention.

(a) The Examiner’s Combination of Schwob and Jurgen is Improper

The Examiner has not identified any evidence of a motivation to combine Schwob and Jurgen to solve the problem which the claimed invention was set out to solve. Although an examiner may formulate an obviousness rejection of a claimed invention based on a combination of prior art references, the examiner is required to provide clear and particular evidence of a suggestion, teaching or motivation to combine such references:

[E]vidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases from the nature of the problem to be solved, although “the suggestion more often comes from the teachings of the pertinent references.” The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.”

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added, citations omitted).

In the Final Office Action, the Examiner postulated use of the Schwob receiver “in combination of [Jurgen’s] GPS.” Page 6 of the Final Office Action (Appendix B). The Examiner went on to make a broad conclusory statement that “one would have been motivated to make such a combination in order to provide a means to update a receiver-integrated database containing station identification and station attribute information so that data update can be done automatically through VHF/FM subcarrier data transmission as soon as data change is known and as easily as practicle (sic).” *Id.*

However, nowhere does Jurgen or Schwob, individually or in combination, teach or suggest use of GPS to update anything of a radio receiver whatsoever. In fact, Jurgen and Schwob teach away from the motivation conjured up by the Examiner. Jurgen teaches use of a DAB radio, apart from being a sound box, as a GPS aid to improve the GPS locating capability. Specifically, Jurgen teaches that “[t]he digital radio may in the future be programmable to correlate and compare signals from the global positioning system [GPS] to pinpoint a driver’s exact location.” Jurgen at page 55. Moreover, Schwob describes a radio receiver capable of receiving current location information within a received data stream, and determining the current location of the receiver. *See* col. 19, line 35 *et seq.*, Fig. 14 of Schwob. If anything, one skilled in the art may have been motivated to combine Schwob and Jurgen to solve the problem of a deficiency of GPS in pinpointing the location of a vehicle or a radio receiver, but certainly not the problem which the claimed invention was set out to solve (*supra* Section V). Thus, the Examiner’s use of a specious motivation to combine Schwob and Jurgen, not to mention broad conclusory statements, to support his attempted hindsight reconstruction of the claimed invention is improper.

(b) The Examiner’s Combination of Schwob and Jurgen
Does Not Produce the Claimed Invention

As admitted by the Examiner in the Final Office Action, Schwob at a minimum fails to teach a processor for “determining whether the vehicle is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources being provided when it is determined that the vehicle is within the predetermined distance from

the second location, the second group of information sources being associated with the second location,” as claim 21 recites. Appendix B, page 2. Nor does Jorgen teach or suggest the quoted claim limitations notwithstanding the Examiner’s assertion that Fig. 2 of Jorgen shows such limitations. *See* Appendix B, page 5. The Examiner mischaracterized Fig. 2 as a demonstration of Jorgen’s “teach[ing that] the digital radio may be programmable to correlate and comparable (sic) signals from the global positioning system to pinpoint a driver’s location calculate a car’s location, transmitting the coordinates of transmission sites and resulting distance difference by GPS location data.” *Id.* The mischaracterization of Fig. 2 aside, the Jorgen teaching as propounded by the Examiner does not even meet the above-quoted claim limitations. Thus, even assuming *arguendo* that it is proper to combine Schwob and Jorgen, the combination of these references still does not produce the claimed invention.

Fig. 2 of Jorgen illustrates use of the aforementioned SFN whereby a driver can have a receiver “automatically tune in to the strongest signal of particular transmitter wherever she may happen to be on her itinerary.” Caption of Fig. 2 of Jorgen (emphasis added). Thus, in fact, Jorgen teaches away from the claimed invention by automatically switching from one transmitter (or station) whose signal is fading to another transmitter (or station) having a stronger signal, thereby obviating the need of providing for selection “a second set of indicators indicating a second group of information sources,” associated with a second location “when it is determined that the vehicle is within the predetermined distance from the second location,” as claims 21 and 41 recite. As such, claims 21 and 41, together with their dependent claims, are patentable over Schwob in view of Jorgen.

The Examiner also mischaracterized the above-quoted claim limitations as an advantage of the invention. The Examiner cited *Ex parte Obiaya*, 227 U.S.P.Q. 58 (Bd. Pat. App & Inter. 1985) for the proposition that “the fact that the applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.” Exhibit B, page 5. However, the Examiner ignores the fact that in the *Obiaya* case, before the Board made such a ruling with respect to an advantage attendant to an invention, it had made the threshold finding that “the references clearly disclose each of the features [of the claimed invention] in similar apparatus

such that one skilled in this art having these references available would have found the claimed invention to be obvious.” *Obiaya* at 60 (emphases added).


Here, the above-quoted claim limitations are features of the invention, as opposed to being an advantage attendant to the invention as postulated by the Examiner. As discussed before, these claim features are not disclosed anywhere, let alone clearly, in the Schwob and/or Jurgen reference, and do not flow naturally from following the suggestion of the prior art anyhow. As such, the Examiner’s position is totally untenable.

IX SUMMARY

In view of the foregoing arguments, it is clear that Schwob and Jurgen, taken singly or in combination, do not render obvious the invention set forth in Appellant's claims. Appellant submits that the Examiner is in error in the characterization of the references. Accordingly, it is respectfully requested that the rejections of Appellant's claims under 35 U.S.C. § 103 be reversed.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

Daniel M. Cavanagh, Reg. No. 41,661
Telephone: 626/795-9900

DMC/rmw

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CLAIMS ON APPEAL

21. A system for use in a vehicle comprising:

an interface for providing a set of indicators for indicating a group of information sources outside the vehicle, the group of information sources being associated with a location, each indicator being selectable to receive signals from the information source indicated by the indicator; and

a processor for determining whether the vehicle is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources being provided when it is determined that the vehicle is within the predetermined distance from the second location, the second group of information sources being associated with the second location.

22. The system of claim 21 wherein at least one of the information sources includes a radio station.

23. The system of claim 21 wherein at least one of the information sources includes a television station.

24. The system of claim 21 wherein at least one of the indicators is selectable by voice command.

25. The system of claim 21 wherein the interface includes a display.

26. The system of claim 25 wherein at least one of the indicators when selected is highlighted on the display.

27. The system of claim 21 wherein the processor determines whether the vehicle is within the predetermined distance from the second location by comparing a global positioning

system (GPS) measurement identifying a current location of the vehicle with a second GPS measurement identifying the second location.

28. The system of claim 21 wherein at least one of the indicators includes an icon.

29. The system of claim 28 wherein the at least one indicator is selectable by pointing and clicking at the icon.

41. A method for use in a system in a vehicle comprising:
providing a set of indicators for indicating a group of information sources outside the vehicle, the group of information sources being associated with a location, each indicator being selectable to receive signals from the information source indicated by the indicator;
determining whether the vehicle is within a predetermined distance from a second location; and
providing a second set of indicators indicating a second group of information sources which is associated with the second location when it is determined that the vehicle is within the predetermined distance from the second location.

42. The method of claim 41 wherein at least one of the information sources includes a radio station.

43. The method of claim 41 wherein at least one of the information sources includes a television station.

44. The method of claim 41 wherein at least one of the indicators is selectable by voice command.

45. The method of claim 41 wherein at least one of the indicators is provided on a display in the system and the at least one indicator when selected is highlighted on the display.

46. The method of claim 41 wherein a GPS measurement identifying a current location of the vehicle is compared with a second GPS measurement identifying the second location in determining whether the vehicle is within the predetermined distance from the second location.

47. The method of claim 41 wherein at least one of the indicators includes an icon.

48. The method of claim 47 wherein the at least one indicator is selectable by pointing and clicking at the icon.

59. The system of claim 21 wherein at least one of the information sources includes a video source.

60. The system of claim 21 wherein at least one of the information sources includes an audio source.

61. The method of claim 41 wherein at least one of the information sources includes a video source.

62. The method of claim 41 wherein at least one of the information sources includes an audio source.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/838,491

04/19/2001

Michael L. Obradovich

56019/DMC/C685

9904

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12/29/2005

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PASADENA, CA 91109-7066

EXAMINER

NGUYEN, CAO H

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,491

Applicant(s)

OBRADOVICH, MICHAEL L.

Examiner

Cao (Kevin) Nguyen

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-48 and 59-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-48 and 59-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21-29, 41-48 and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwob (US Patent No. 5,732,338) in view of Ronald Jurgen, IEEE Spectrum (March 1996).

Regarding claim 21, Schwob discloses a system for use in a vehicle comprising: an interface for providing a set of indicators for indicating a group of information sources outside the vehicle, the group of information sources being associated with a location, each indicator being selectable to receive signals from the information source indicated by the indicator (see col. 10, lines 41-62 and col. 11, lines 1-61); however, Schwob fails to explicitly teach a processor for determining whether the vehicle is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources being provided when it is determined that the vehicle is within the predetermined distance from the second location, the second group of information sources being associated with the second location.

Jurgen teaches a processor for determining whether the vehicle is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources being provided when it is determined that the vehicle is within the predetermined distance from the second location, the second group of information sources being associated with the second location (see pages 54-55). It would have been obvious to one of an ordinary skill in the art, having the teaching of Schwob and Jursen before him at the time the invention was made to modify whether the vehicle, is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources, which is associated with the second location, being provided when it is determined that the vehicle is within the predetermined distance from the second location as taught by Jurgen to the broadcasting and receiving system of Schwob.

One would have been motivated to make such a combination in order to provide a means to update a receiver-integrated database containing station identification and station attribute information so that data update can be done automatically through VHF/FM subcarrier data transmission as soon as data change is known and as easily as practice.

Regarding claim 22, Schwob discloses wherein at least one of the information sources includes a radio station (see col. 2, lines 33-46).

Regarding claim 23, Schwob discloses wherein at least one of the information sources includes a television station (see col. 2, lines 47-56).

Art Unit: 2173

Regarding claims 24-26, Schwob discloses wherein at least one of the indicators when selected is highlighted on the display (see col. 20, lines 18-32).

Regarding claims 27, Jurgen discloses wherein the processor determines whether the vehicle is within the predetermined distance from the second location by comparing a global positioning system (GPS) measurement identifying a current location of the vehicle with a second GPS measurement identifying the second location (see page 55).

Regarding claim 28 and 29, Schwob discloses wherein at least one of the indicators includes an icon and wherein the at least one indicator is selectable by pointing and clicking at the icon (see col. 29, lines 39-45).

Claim 41 differs from claim 1 in that " providing a set of indicators for indicating a group of information sources outside the vehicle, the group of information sources being associated with a location, each indicator being selectable to receive signals from the information source indicated by the indicator; determining whether the vehicle is within a predetermined distance from a second location; and providing a second set of indicators indicating a second group of information sources which is associated with the second location when is determined that the vehicle is within the predetermined distance from the second location." which read on Schwob (see col. 20-23, lines 1-67).

As claim 42-48 and 59-62 are analyzed as previously discussed with respect to claims 21-30 above.

Response to Argument

3. Applicant's arguments filed on 10/11/05 have been fully considered but they are not persuasive.

On pages 8-10 of the Remark; Applicant argues that the combination of Schwob and Jursen do not teach or suggest "whether the vehicle, is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources, which is associated with the second location, being provided when it is determined that the vehicle is within the predetermined distance from the second location." The Examiner respectfully disagrees. As shown in figure 2; Jursen teaches the digital radio may be programmable to correlate and comparable signals from the global positioning system to pinpoint a driver's location calculate a car's location, transmitting the coordinates of transmission sites and resulting distance difference by GPS location data; as recited in pages 53-56.

In response to applicant's argument that whether the vehicle, is within a predetermined distance from a second location, a second set of indicators indicating a second group of information sources, which is associated with the second location, being provided when it is determined that the vehicle is within the predetermined distance from the second location, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Art Unit: 2173

In response to applicant's argument on page 8 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schwob discloses a system for use in a vehicle used in combination of Jursen's GPS. One would have been motivated to make such a combination in order to provide a means to update a receiver-integrated database containing station identification and station attribute information so that data update can be done automatically through VHF/FM subcarrier data transmission as soon as data change is known and as easily as practicable.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (see PTO-892).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

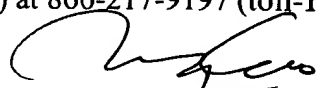
Art Unit: 2173

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cao (Kevin) Nguyen
Primary Examiner
Art Unit 2173

12/22/05

patent violate the written description requirement of section 112, §1. But to state the argument is to realize its objection; as we discussed above, the written description of the '835 patent provides ample support for the ordinary and accustomed meaning of the terms of the '835 claims. Thus, the '835 claims, as construed by the district court and this court, are entitled to the benefit of the filing date of the '586 application. No violation of section 102(b)'s on-sale bar has occurred.

IV

Zebco has failed to demonstrate to this court that the disputed claim terms of claim 1 of the '835 patent should be interpreted in a way other than their ordinary and accustomed meaning. Therefore, we find that the district court's claim interpretation, and the summary judgment of infringement conditioned thereon, was not erroneous. We also hold that the district court correctly determined that the relevant claim of the '835 patent, as construed, is not invalid. The judgment of the district court is affirmed.

AFFIRMED.

U.S. Court of Appeals
Federal Circuit

In re Dembiczak

No. 98-1498

Decided April 28, 1999

PATENTS

1. Patentability/Validity — Obviousness — Combining references (§115.0905)

Decision rejecting claims in utility application as obvious over combination of prior art references must be reversed; since obviousness analysis in decision is limited to discussion of ways that multiple references can be combined to read on claimed invention, but does not particularly identify any suggestion, teaching, or motivation to combine references, and does not include specific or inferential findings concerning identification of relevant art, level of ordinary skill in art, nature of problem to be solved, or any other factual findings that might support proper obviousness analysis.

2. Patentability/Validity — Anticipation — Double patenting (§115.0708)

Obviousness-type double patenting may be found between design and utility patents in rare cases, but such rejection is appropriate only if claims of two patents cross-read, meaning that subject matter of claims of patent sought to be invalidated would have been obvious from subject matter of claims of other patent, and vice-versa.

3. Patentability/Validity — Anticipation — Double patenting (§115.0708)

Applicants' design patents for bag with jack-o'-lantern face would not have been obvious variants of their pending utility claims directed to trash bag decorated to resemble Halloween pumpkin when filled with trash or leaves, since textual description of "facial indicia" on bag found in claims of utility patent application cannot constitute design reference that is "basically the same as" specific designs claimed in applicants' patentably distinct design patents.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application of Anita Dembiczak and Benson Zinbarg for utility patent (application serial no. 08/427,732). From decision sustaining rejections of claims in application, applicants' appeal reversed.

David P. Gordon and Thomas A. Gallagher, Stamford, Conn., for appellants.

John M. Whealan, associate solicitor, Albin F. Drost, acting solicitor, and David R. Nicholson, associate solicitor, Office of the Solicitor, Arlington, Va., for appellee.

Before Mayer, chief judge, and Michel and Clevenger, circuit judges.

Clevenger, J.

Anita Dembiczak and Benson Zinbarg appeal the rejection, upheld by the Board of Patent Appeals and Interferences, of all pending claims in their Application No. 08/427,732. See *Ex Parte Dembiczak*, No. 96-2648, slip op. at 43 (May 14, 1998). Because the Board erred in sustaining rejections of the pending claims as obvious under 35 U.S.C. § 103(a) (Supp. 1998), and for obviousness-type double patenting, we reverse.

I

The invention at issue in this case is, generally speaking, a large trash bag made of orange plastic and decorated with lines and facial features, allowing the bag, when filled with trash or leaves, to resemble a Halloween-style pumpkin, or jack-o'-lantern. As the inventors, Anita Dembiczak and Benson Zinbarg (collectively, "Dembiczak") note, the invention solves the long-standing problem of unsightly trash bags placed on the curbs of America, and, by fortuitous happenstance, allows users to express their whimsical or festive nature while properly storing garbage, leaves, or other household debris awaiting collection. Embodiments of the invention—sold under a variety of names, including Giant Stuff-A-Pumpkin®, Funkins, Jack Sak®, and Bag-O-Fun®—have undisputedly been well-received by consumers, who bought more than seven million units in 1990 alone. Indeed, in 1990, the popularity of the pumpkin bags engendered a rash of thefts around Houston, Texas, leading some owners to resort to preventative measures, such as greasing the bags with petroleum jelly and tying them to trees. See R. Pillar, "Halloween Hopes Die on the Vine," *Hous. Chron.*, Oct. 19, 1990, at 13A.

The road to profits has proved much easier than the path to patentability, however. In July 1989, Dembiczak filed a utility patent application generally directed to the pumpkin bags. In a February 1992 appeal, the Board of Patent Appeals and Interferences ("the Board") reversed the Examiner's rejection, but entered new grounds for rejection. Dembiczak elected to continue prosecution, filing a continuation application to address the new grounds for rejection. Thereafter, the invention made a second appearance before the Board, in April 1993, when the Board both sustained the Examiner's rejection and again entered new grounds for rejection. Again, a continuation application was filed (the instant application). And again the Examiner's rejection was appealed to the Board, which sustained the rejection in a May 14, 1998, decision. See *Dembiczak*, slip op. at 43.

A

The patent application at issue includes claims directed to various embodiments of the pumpkin bag. Claims 37, 49, 51, 52, 58 through 64, 66 through 69, and 72 through 81 are at issue in this appeal. Though the

claims vary, independent claim 74 is perhaps most representative:

74. A decorative bag for use by a user with trash filling material, the bag simulating the general outer appearance of an outer surface of a pumpkin having facial indicia thereon, comprising:

a flexible waterproof plastic trash or leaf bag having

an outer surface which is premanufactured orange in color for the user to simulate the general appearance of the outer skin of a pumpkin, and having facial indicia including at least two of an eye, a nose and a mouth on the orange color outer surface for forming a face pattern on said orange color outer surface to simulate the general outer appearance of a decorative pumpkin with a face thereon,

said trash or leaf bag having first and second opposite ends, at least said second end having an opening extending substantially across the full width of said trash or leaf bag for receiving the trash filling material,

wherein when said trash or leaf bag is filled with trash filling material and closed, said trash or leaf bag takes the form and general appearance of a pumpkin with a face thereon.

All of the independent claims on appeal, namely 37, 52, 72, and 74, contain limitations that the bag must be "premanufactured orange in color," have "facial indicia," have openings suitable for filling with trash material, and that when filled, the bag must have a generally rounded appearance, like a pumpkin. Independent claims 37, 52, and 72 add the limitation that the bag's height must be at least 36 inches. Claim 72 requires that the bag be made of a "weatherproof material," and claim 74, as shown above, requires that the bag be "waterproof." Claim 52 recites a "method of assembling" a bag with the general characteristics of apparatus claim 37.

B

The prior art cited by the Board includes:

(1) pages 24-25 of a book entitled "A Handbook for Teachers of Elementary Art," by Holiday Art Activities ("Holiday"), describing how to teach children to make a "Crepe Paper Jack-O-Lantern" out of a strip of orange crepe paper, construction paper cut-outs in the shape of facial features, and "wadded newspapers" as filling;

(2) page 73 of a book entitled "The Everything Book for Teachers of Young Chil-

dren," by Martha Shapiro and Valerie Indenbaum ("Shapiro"), describing a method of making a "paper bag pumpkin" by stuffing a bag with newspapers, painting it orange, and then painting on facial features with black paint;

(3) U.S. Patent No. 3,349,991 to Leonard Kessler, entitled "Flexible Container" ("Kessler"), describing a bag apparatus wherein the bag closure is accomplished by the use of folds or gussets in the bag material;

(4) U.S. Patent No. Des. 310,023, issued August 21, 1990 to Dembiczak ("Dembiczak '023"), a design patent depicting a bag with a jack-o'-lantern face;

(5) U.S. Patent No. Des. 317,254, issued June 4, 1991 to Dembiczak ("Dembiczak '254"), a design patent depicting a bag with a jack-o'-lantern face; and,

(6) Prior art "conventional" plastic lawn or trash bags ("the conventional trash bags").

Using this art, the Board affirmed the Examiner's final rejection of all the independent claims (37, 52, 72, 74) under 35 U.S.C. § 103, holding that they would have been obvious in light of the conventional trash bags in view of the Holiday and Shapiro references. The Board determined that, in its view of the prior art, "the only difference between the invention presently defined in the independent claims on appeal and the orange plastic trash bags of the prior art and the use of such bags resides in the application of the facial indicia to the outer surface of the bag." *Dembiczak*, slip op. at 18. The Board further held that the missing facial indicia elements were provided by the Holiday and Shapiro references' description of painting jack-o'-lantern faces on paper bags. *See id.* at 18-19. Dependent claims 49 and 79, which include a "gussets" limitation, were considered obvious under similar reasoning, except that the references cited against them included Kessler. *See id.* at 7.

The Board also affirmed the Examiner's obviousness-type double patenting rejection of all the independent claims in light of the two Dembiczak design patents ('023 and '254) and Holiday. *See id.* at 12. The Board held that the design patents depict a generally rounded bag with jack-o'-lantern facial indicia, and that the Holiday reference supplies the missing limitations, such as the "thin, flexible material" of manufacture, the orange color, the initially-open upper end, and the trash filling material. The Board also stated that the various limitations of the dependent claims—e.g., color, the inclusion of leaves as stuffing, and the dimensions—would all be obvious variations of the depic-

tions in the Dembiczak design patents. *See id.* at 8-9. In addition, using a two-way test for obviousness-type double patenting, the Board held that the claims of the Dembiczak design patents "do not exclude" the additional structural limitations of the pending utility claims, and thus the design patents were merely obvious variations of the subject matter disclosed in the utility claims. *See id.* at 11. The Board further upheld, on similar grounds and with the inclusion of the Kessler reference, the obviousness-type double patenting rejection of dependent claim 49. *See id.* at 12.

This appeal followed, vesting this court with jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A) (1994).

II

A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a) (Supp. 1998); *see Graham v. John Deere Co.*, 383 U.S. 1, 14, 148 USPQ 459, 465 (1966). The ultimate determination of whether an invention is or is not obvious is a legal conclusion based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *See Graham*, 383 U.S. at 17-18, 148 USPQ at 467; *Miles Labs, Inc., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 USPQ2d 1123, 1128 (Fed. Cir. 1993). We therefore review the ultimate determination of obviousness without deference to the Board, while examining any factual findings for clear error. *See, e.g., In re Zurko*, 142 F.3d 1447, 1459, 46 USPQ2d 1691, 1700 (Fed. Cir.) (en banc), cert. granted, 119 S. Ct. 401 (1998).

A

Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight," *see Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by *Nobel-pharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir.

1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 383 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138,

227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977) ("The examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection."). In addition to demonstrating the propriety of an obviousness analysis, particular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.

[1] All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. See *Dembiczak*, slip op. at 6-7. To justify this combination, the Board simply stated that "the Holiday and Shapiro references would have

suggested the application of . . . facial indicia to the prior art plastic trash bags." *Id.* at 18-19. However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other—in combination with each other and the conventional trash bags—described all of the limitations of the pending claims. *See id.* at 18-28. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific—or even inferential—findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. *See, e.g., Pro-Mold & Tool*, 75 F.3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a "premanufactured orange" bag material, *see Dembiczak*, slip op. at 21, finds that Shapiro teaches the use of paper bags in various sizes, including "large", *see id.* at 22-23, and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice, *see id.* at 24. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. *See Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1459 (noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination"). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. *See C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232; *Rouffet*, 149 F.3d at 1359, 47 USPQ2d at 1459; *Fritch*, 972 F.2d at 1265, 23 USPQ2d at 1783; *Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600; *Ashland Oil*, 776 F.2d at 297, 227 USPQ at 667.

B

The Commissioner of Patents and Trademarks ("Commissioner") attempts to justify the Board's decision on grounds different from that relied upon by the Board, arguing that one of ordinary skill in the art would have been motivated to combine the references. Of course, in order to do so, the Commissioner must do what the Board did not do below: make specific findings of fact regarding the level of skill in the art ("a designer and manufacturer of trash and leaf bags, particularly one specializing in the ornamental and graphic design of such bags"), *Resp't Br.* at 14, the relationship between the fields of conventional trash bags and children's crafts, respectively ("[t]he artisan would also have been well aware of the ancillary, corollary, and atypical uses of 'trash' bags such as their application in hobby and art projects"), *Resp't Br.* at 15, and the particular features of the prior art references that would motivate one of ordinary skill in a particular art to select elements disclosed in references from a wholly different field ("a designer and manufacturer of trash and leaf bags would have recognized the paper bag in Shapiro to be a trash bag and therefore would have been motivated to combine it with the admitted prior art plastic trash and leaf bags to arrive at the claimed invention"), *Resp't Br.* at 15. The Commissioner also appears to cite additional references in support of his obviousness analysis, noting that at least two design patents (in the record but not cited against the presently pending claims) teach the placement of "graphical information, including text, designs, and even facial indicia, to colored bags." *Resp't Br.* at 16. This new analysis, apparently cut from whole cloth in view of appeal, does little more than highlight the shortcomings of the decision below, and we decline to consider it. *See, e.g., In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999) ("We decline to consider [the Commissioner's] newly-minted theory as an alternative ground for upholding the agency's decision."); *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995); *In re Hounsfeld*, 699 F.2d 1320, 1324, 216 USPQ 1045, 1049 (Fed. Cir. 1983) (rejecting an "attempt[] by the Commissioner to apply a new rationale to support the rejection."); *see also* 35 U.S.C. § 144 (1994) (an appeal to the Federal Circuit "is taken on the record before The Patent and Trademark Office"). Because the Board has not established a *prima facie* case of obviousness, *see In re Bell*, 991 F.2d 781,

783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) ("The PTO bears the burden of establishing a case of *prima facie* obviousness."), we therefore reverse the obviousness rejections, and have no need to address the parties' arguments with respect to secondary factors.

III

Dembiczak also asks this court to reverse the Board's rejection of the pending claims for obviousness-type double patenting, which is a judicially-created doctrine that seeks to prevent the applicant from expanding the grant of the patent right beyond the limits prescribed in Title 35. *See, e.g., In re Braat*, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); *In re Longt*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). *See also* 35 U.S.C. § 154(a)(2) (Supp. 1998) (discussing patent term). The doctrine prohibits claims in a second patent which define "merely an obvious variation" of an invention claimed by the same inventor in an earlier patent. *Braat*, 937 F.2d at 592, 19 USPQ2d at 1292 (quoting *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970)). Thus, unless a claim sought in the later patent is patentably distinct from the claims in an earlier patent, the claim must be rejected. *See In re Goodman*, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); *Vogel*, 422 F.2d at 441, 164 USPQ at 622. This question is one of law, which we review *de novo*. *See Goodman*, 11 F.3d at 1052, 29 USPQ2d at 2015; *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

A

[2] The law provides that, in some very rare cases, obvious-type double patenting may be found between design and utility patents. *See Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-40, 220 USPQ 481, 487 (Fed. Cir. 1983) (noting that, while theoretically possible, "[d]ouble patenting is rare in the context of utility versus design patents"); *In re Thorington*, 418 F.2d 528, 536-37, 163 USPQ 644, 650 (CCPA 1969) (Double patenting between a design and utility patent is possible "if the features producing the novel aesthetic effect of a design patent or application are the same as those recited in the claims of a utility patent or application as producing a novel structure."); *In re Phelan*, 205 F.2d 183, 98 USPQ 156 (CCPA 1953);

In re Barber, 81 F.2d 231, 28 USPQ 187 (CCPA 1936); *In re Hargraves*, 53 F.2d 900, 11 USPQ 240 (CCPA 1931). In these cases, a "two-way" test is applicable. *See Carman*, 724 F.2d at 940, 220 USPQ at 487. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *Id.*, 220 USPQ at 487. *See also Braat*, 937 F.2d at 593, 19 USPQ2d at 1292 (explaining two-way test).

B

In making its double patenting rejection, the Board concluded that all but one of the pending claims of Dembiczak's utility application would have been merely an obvious variation of the claims of the earlier-issued design patents—the Dembiczak '023 and '254 references—in light of the Holiday reference. The remaining claim, dependent claim 49, was judged obvious in light of the combination of the Dembiczak design patents, Holiday, and the Kessler reference.

[3] Acknowledging that the two-way test was required by *Carman*, 724 F.2d at 940, 220 USPQ at 487, the Board concluded that "the design claimed in each of appellants' design patents does not exclude the features pertaining to the construction and color of the bag, the use of a plastic material for making the bag, the size or thickness of the bag . . . or the use of various types of filling material The particular details of the facial indicia would have been a matter of design choice as evidenced by the Holiday handbook," and that therefore, in view of Holiday, the claims of the design patents were obvious variants of the pending utility patent claims. *See Dembiczak*, slip op. at 11. We disagree. In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are "basically the same as the claimed design." *In re Borden*, 90 F.3d 1570, 1574, 39 USPQ2d 1524, 1526 (Fed. Cir. 1996); *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982). The phrase "having facial indicia thereon" found in the claims of the pending utility application is not a design reference that is "basically the same as the claimed design." *Borden*, 90 F.3d at 1574, 39 USPQ2d at 1526. In fact, it describes precious little with respect to design charac-

teristics. The Board's suggestion that the design details were simply "a matter of design choice" evinces a misapprehension of the subject matter of design patents. *E.g.*, *Carman*, 724 F.2d at 939 n.13, 220 USPQ at 486 n.13 ("Utility patents afford protection for the mechanical structure and function of an invention whereas design patent protection concerns the ornamental or aesthetic features of a design.") Indeed, we note that the two design patents at issue here—the Dembiczak '023 and '254 patents—were considered nonobvious over each other, and were even the subject of a restriction requirement. *See* 35 U.S.C. § 121 (1994) ("If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions."); 37 C.F.R. § 1.142. The position adopted by the Board—that a textual description of facial indicia found in the claims of the utility patent application makes obvious the specific designs claimed in the (patentably distinct) Dembiczak design patents—would presumably render obvious, or even anticipate, all design patents where a face was depicted on a bag. But this, of course, is not the law; the textual description cannot be said to be a reference "basically the same as the claimed design," of the design patents at issue here. *Borden*, 90 F.3d at 1574, 39 USPQ2d at 1526 (internal quotation marks omitted). The Board's conclusion of obviousness is incorrect.

Because we find that the Board erred in concluding that the design patents were obvious variants of the pending utility claims, we need not address the other prong of the two-way double patenting test—whether the pending utility claims are obvious variations of the subject matter claimed in the design patents. *See Carman*, 724 F.2d at 939, 220 USPQ at 487 (both prongs of the two-way test required for obviousness-type double patenting). The double patenting rejections are reversed.

IV

Because there is no evidence in the record of a suggestion, teaching, or motivation to combine the prior art references asserted against the pending claims, the obviousness rejections are reversed. In addition, because the Board misapprehended the test for obviousness-type double patenting, and because the pending utility claims do not render obvious the design patents, the double patenting rejections are also reversed.

REVERSED.

U.S. District Court Southern District of Iowa

University of Iowa Research Foundation v.
Beveridge, DeGrandi, Weilacher & Young
L.L.P.

No. 3-98-CV-90013

Decided August 26, 1998

JUDICIAL PRACTICE AND PROCEDURE

1. Jurisdiction — Personal jurisdiction (\$405.11)

Federal court in Iowa lacks specific personal jurisdiction over Washington, D.C. law firm and attorney named as defendants in action for professional malpractice, since defendants did not "purposefully direct" their activities at Iowa, given that defendants are charged only with negligently failing to pay maintenance fee on single patent, and that all work done in connection with that patent was performed in Washington, D.C., since single claim of legal malpractice with respect to payment of maintenance fee in Washington, D.C. cannot be said to have "arisen out of" or resulted from attorney-client relationship that began in Iowa 30 years earlier, since nature and quality of defendants' contacts with Iowa do not demonstrate how they "purposefully availed" themselves of privileges and protections of doing interstate patent work for plaintiff, and since quantity of defendants' contacts with Iowa alone does not change conclusion that assertion of personal jurisdiction over defendants would be fundamentally unfair.

Action by University of Iowa Research Foundation against Beveridge, DeGrandi, Weilacher & Young L.L.P. and Richard G. Young for professional malpractice. On defendants' motion to dismiss for lack of personal jurisdiction. Granted.

Edmund J. Sease and Jeffrey D. Harty, of Zarley, McKee, Thomte, Voorhees & Sease, Des Moines, Iowa, for plaintiff.

Lee H. Gaudineer and Carlton G. Salmons, of Austin, Gaudineer & Comito, Des Moines; Steven Verveniots and Mark K. Anesh, of Wilson, Elser, Moskowitz, Edel-

of the majority, nowhere found in the complaint. In the second cause of action, after identifying the parties, plaintiff alleges that she sold to defendant the right to produce her design solely on fabric and defendant without authorization thereafter licensed Sunweave Linen Corp. and Lord & Taylor to reproduce the design on products other than fabric "in direct contravention of the terms of the agreement between plaintiff and defendant." Plaintiff concludes: "Defendant required Sunweave and Lord & Taylor, to place on certain of the unauthorized products sold by Sunweave and Lord & Taylor, containing the Design, a credit for the Design stating it was 'designed by Waverly', even though in truth and in fact defendant knew that such pattern was designed by the plaintiff, to the damage of the plaintiff in the sum of \$25,000." It is undisputed that the contract referred to by plaintiff was never reduced to writing.

The oral contract is thus plainly at the heart of the second cause of action. Plaintiff contends that she sold a limited right, permitting defendant to use the design solely on fabric and wallpaper, while defendant claims that it purchased all of plaintiff's right, title and interest in the design, and consequently that its use was unrestricted. If plaintiff sold a limited right only — her version of the contract — defendant breached the contract and thereby misappropriated the design and misrepresented ownership. If plaintiff sold defendant all rights in the design — defendant's version of the contract — then it could lawfully place its own name on and market its property, without further permission from plaintiff.

Even if the second cause of action were not preempted by federal law, still there would be no enforceable claim because of the Statute of Frauds. The very design of the Statute of Frauds was "not to trust the memory of witnesses for a longer time than one year." (*Smith v. Westfall*, 1 Lord Raymond 316, 317 [1697], quoted in *D & N Boening v Kirsch Beverages*, 63 NY2d 449, 454.) The requirement of a writing assures that there will be reliable evidence of the terms of a contract, an objective which is defeated and circumvented by permitting plaintiff, in a dispute over the terms of a contract, to enforce what is merely one version of the contract in the guise of a tort.

A reading of the second cause of action as pleaded in the complaint reveals that it is not, as the majority describes, premised on "unfair competition" (slip opn, p 4), but — to use plaintiff's own words — on "direct contravention of the terms of the agreement between plaintiff and defendant." (Complaint, ¶7.) In contracts for the sale of products, any purchaser exercising dominion over the products, including placing its name on what it believes it

rightly owns, can be said by a seller charging breach of contract to be misappropriating, misrepresenting, falsely labeling, or using the property in "other and deceitful ways" (slip opn, p 4, n*), but a contract action does not without more become a tort action. In the cases cited by the majority for the proposition that the use of property in "other and deceitful ways" may give rise to a tort action — *North Shore Bottling, Rich, Fantis Foods and Albe-marle Theatre* (slip opn, pp 4-5, n*) — there was not, as here, a fundamental dispute regarding the terms of the contract, which would itself be wholly determinative of the "tort" issue.

Characterization of the alleged breach of contract as a tort does not breathe vitality into a contract otherwise unenforceable for want of a writing. (See, e.g., *Intercontinental Planning v Daystrom, Inc.*, 30 AD2d 519, *affd* 24 NY2d 372.) Not one of the misappropriation cases cited by the majority involves an acknowledged contract between the parties permitting defendant in the first instance to use plaintiff's property, and a mere dispute as to the reach of the contract.

We have only recently reaffirmed the principle with respect to the Statute of Limitations that where an action is fundamentally contractual, plaintiff cannot rely on incidental allegations of fraud to keep its lawsuit viable. (*Queensbury Union Free Sch. Dist. v Jim Walter Corp.*, 101 AD2d 992, 993, *affd* 64 NY2d 964 [decided March 21, 1985].) By the same token, plaintiff should not be permitted to avoid the Statute of Frauds by enforcing an oral contract as a tort action for "false labeling."

I would therefore affirm the Appellate Division order in its entirety.

Patent and Trademark Office Board of Patent Appeals and Interferences

Ex parte Obiaya

Opinion dated July 23, 1985

PATENTS

1. Patentability — Invention — In general (\$51.501)

Inventor's recognition of another advantage that would flow naturally from following suggestion of prior art cannot be basis of patent-

ability when differences would otherwise be obvious.

2. Double patenting — In general (§33.1)

Reissue — In general (§58.1)

Double patenting rejections are analogous to Section 103 rejections and depend on presence of prior "patent" as basis for rejection, and thus such rejection falls within ambit of those intended by reexamination statute.

Particular Patents — Combustible Element

4,128,458, Obiaya, Combustible Element and Oxygen Concentration Sensor, Claims 1-13, rejected.

Appeal from Art Unit 112.

Reexamination No. 90/000,449, for No. 4,128,458, issued Dec. 5, 1978, based on application, Serial No. 845,049, filed Oct. 25, 1977. Rejection of Claims 1-13, sustained.

Stephen J. Schultz, for appellant.

Before Merker, Katz, and Pellman, Examiners-in-Chief.

Katz, Examiner-in-Chief.

This is a reexamination of Patent No. 4,128,458 and was requested by the defendant in an infringement suit brought by patentee.

This is an appeal from the final rejection of claims 1 through 14, which are all the claims in the case.

Claims 1 and 6 are illustrative of the appealed claims and read as follows:

1. A combustible fluid and oxygen concentration sensor comprising:

- a. a combustible concentration analyzer;
- b. an oxygen concentration analyzer;
- c. conduit means for routing a fluid sample past said combustible concentration analyzer and oxygen concentration analyzer;
- d. an inlet port to said conduit means for receiving a sample fluid;
- e. an outlet port from said conduit means for ejecting said sample after analysis;
- f. means for producing fluid flow in said conduit means from said inlet port to said outlet port;
- g. means to correct the combustible concentration analyzer to an indicator; and
- h. means to connect the oxygen analyzer to a second indicator;
- i. said conduit means comprising:

- i. first and second portions arranged to divide the flow into separate paths downstream from said inlet and upstream from said flow producing means;
- ii. said first portion supplying the oxygen analyzer but not the combustible analyzer [sic, analyzer] with sample fluid;
- iii. said second portion supplying the combustible analyzer but not the oxygen analyzer with sample fluid;
- iv. a heater associated with said second portion upstream of said combustible analyzer; and
- v. an inlet for providing air to said second portion upstream of said heater, to insure complete combustible analysis within said combustible analyzer.

6. The combustible fluid and oxygen concentration analyzer of Claim 4 where said oxygen concentration analyzer comprises:

- a. a reactor member;
- b. a heater element, configured in the form of a mesh structure, embedded within said reactor member; and
- c. a base for mounting said reactor member;
- d. said reactor member comprising:
 - i. an electrolyte with oxygen ion vacancies providing paths for oxygen ion conduction;
 - ii. a first and second conductive electrode for inducing a voltaic reaction within said source, and
 - iii. means for connecting said first and second conductive electrodes to external means for measuring the voltage difference created in said electrodes by said voltaic reaction.

The claimed invention relates to a sensor containing a combustion fluid and oxygen concentration analyzer in which a fluid sample is drawn into the sensor apparatus and separated into two parts, one part going to the oxygen analyzer and the other part going to the combustion analyzer. A heater is employed to maintain the sample going to the combustion analyzer at a constant temperature to obtain uniform results. An inlet is also provided such that air can be used to combust the materials going to the combustion analyzer. The components of the oxygen analyzer are set out in greater detail in claims 6 and 13.

The references relied on are:

Lamb et al.	1,321,063	Nov. 4, 1919
Yant et al.	2,531,592	Nov. 28, 1950
Cherry	2,743,167	Apr. 24, 1956
Ross et al.	3,960,500	June 1, 1976
Fisher	4,063,898	Dec. 20, 1977
Obiaya	4,129,491	Dec. 12, 1978

"Product Specification E65-1, Oxygen and Combustibles Analyzer," 1956

"Bailey Product Instructions E65-6, Gas Analyzers Type OA, OB and OC", 1965

"Product Instructions E65-15, Heat Prover Combustion Analyzer", 1956

Bulletin P-23 of Thermox Instruments, Inc., 1976

Claims 1, 2, and 7 stand rejected under 35 U.S.C. 103 in view of the combination of OC Analyzer, Heat Prover or E65-1 in view of Ross et al. Claims 3, 4, 8 through 11 and 14 stand rejected for the same reasons and further in view of Yant et al., Lamb et al. or Cherry. Claim 7 stands rejected for the same reasons and further in view of Thermox. Claims 8 and 11 stand rejected under 35 U.S.C. § 103 in view of the combination of OC Analyzer, Heat Prover or E65-1 taken with Ross et al., Thermox and Yant et al., Lamb et al. or Cherry. Claims 5 and 12 stand rejected under 35 U.S.C. § 103 over OC Analyzer, Heat Prover or E65-1 taken with Ross et al. and either Yant et al., Lamb et al. or Cherry and further in view of Fisher. Claims 6 and 13 stand rejected under the judicially-created doctrine of obvious type double patenting in view of the combination of the patented subject matter of claims 1 through 3, 6 and 7 of Obiaya taken with OC Analyzer, Heat Prover or E65-1 with Ross et al. and also either Yant et al., Lamb et al. or Cherry.

We have carefully considered the arguments in this case and find that we agree with the examiner for the reasons set forth in the Answer. We adopt these reasons as our own and add the following only for purpose of emphasis.

In view of the fact that the examiner has answered each of the points made by appellant, it would be redundant to repeat these points. We will restrict our comments to the highlights of the appeal.

The main features of the claimed invention relate to the parallel flow of a divided sample to two different analyzers, a vacuum to draw the sample to the analyzers and then to exhaust, and a heater means upstream of a combustion analyzer. A number of the claims call for specific features, such as a labyrinth heater, a pressure regulator and the use of a specific combustion sensor.

We believe that the references clearly disclose each of the features in similar apparatus such that one skilled in this art having these references available would have found the claimed invention to be obvious. The examiner has established a *prima facie* case of obviousness. See *In re Lintner*, 458 F.2d 1013, 173

USPQ 560 (CCPA 1972) and *In re Greenfield*, 571 F.2d 1185, 197 USPQ 227 (CCPA 1978). A number of the references, exemplified by E65-1, disclose that it is well-known to divide a sample into separate parts and pass one part to an oxygen sensor and the other part to a combustion sensor, the parts then being recombined and exhausted. Ross et al. disclose that the art recognizes that samples may be aspirated or sucked into the system so as to pass through the sensor. A number of the references disclose labyrinth heaters, pressure regulators and, as set forth in the claims of the Obiaya patent, combustion analyzers of the type described in claims 6 and 13, now before us.

Appellant has pointed out the deficiencies in each of the references. However, the rejection is based on the combination of references. The test of obviousness under 35 U.S.C. §103 is not the express suggestion of the claimed invention in any or all of the references, but what the references taken collectively would suggest to those of ordinary skill in the art presumed to be familiar with them. Note *In re Rosselet*, 347 F.2d 847, 146 USPQ 183 (CCPA 1965) and *In re Simon*, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972). We believe that one skilled in this art would have understood that the various features of the references could be combined to obtain the expected additive results.

[1] Appellant has presented evidence to indicate that a shorter response time is obtained when a labyrinth heater is employed, this being an unexpected result. However, the references disclosing labyrinth heaters indicate that the advantage obtained by using such heaters is that samples are maintained at a uniform temperature. The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Note *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

The examiner has rejected claims 6 and 13 on the judicially-created doctrine of double patenting of the obviousness type. The determination of whether the rejection is proper under the reexamination statute is a question of first impression. The Statute governing reexamination of patents is contained in 35 U.S.C. §301-307.

35 U.S.C. §301 contains the key language that:

"Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications." (emphasis added).

Section 302 states that a request for re-examination by the Office of any claim of a patent may be:

"on the basis of any *prior art* cited under the provisions of Section 301." (emphasis added).

However, Section 303(a) states that the Commissioner, on his own initiative, may initiate a reexamination procedure.¹ He may determine whether a substantial new question of patentability has been raised by the request with or without consideration of *other patents* or printed publications, as well as those cited pursuant to Section 301. We note that the words "*prior art*," used in Sections 301 and 302, do not appear in this Section.

The Statute refers to both patents and printed publications. Patents are printed as publications by most countries,² and if they are to be used only in such capacity then there would have been no reason for this redundancy. We must assume that Congress intended patents to also be the basis for rejection other than as a printed publication. Thus, patents may be used as evidence of prior inventorship by another or as evidence that the patentee of the reexamination patent has already obtained patent protection for his invention. The second patent would be barred by Section 101 if the inventions are identical or by the judicially-created doctrine of double patenting of the obviousness type, if there are only obvious differences between the claims of the respective patents.

However, Section 301 contains the limitation "*prior art*" to describe the patents and printed publications. Normally, "*prior art*" rejections exclude those based on public use or sale and those based on Section 112.³

[2] Where do "double patenting rejections of the obviousness type" fit in? Are they permissible under the reexamination statute, or are they, like public use and sale rejections, and Section 112 rejections (except as to new and amended claims), excluded? *In re Etter*, *supra*, states (225 USPQ p. 4):

"Patent claims are reexamined only in light of patents and printed publications under 35 U.S.C. §§102, 103 . . ."

Double patenting rejections are analogous to Section 103 rejections and depend on the pres-

ence of a prior "patent" as the basis for the rejection. Thus, we take the position that such rejection falls within the ambit of those intended by the statute and are not specifically excluded by the *Etter* case. Further, the *Etter* court focused on the question of presumption of validity with regard to a reexamination patent and its statement as to the scope of proper rejections in the evaluation of a reexamination patent are not the point of the ruling.

We now deal with the *merits* of the double patenting rejection. The rejection is based on the evidence that the general combination of oxygen and combustion analyzers used with sampling devices is known and that it would have been obvious to employ the particular oxygen analyzer defined in the claims of the Obiaya patent in combination with the sampling device. We believe that claims to such combination do not define a separate and distinct invention from the claims to the oxygen analyzer.

Appellant has indicated that it would be futile to add a terminal disclaimer to this reexamination application since this application has a patent date which is earlier than that of the other Obiaya patent. It appears that appellant's choice is clear. He may acquiesce in the double patenting rejection or he may file a terminal disclaimer in his other patent, assuming that the Obiaya patent and the present application are commonly owned.

The decision of the examiner is affirmed.

AFFIRMED.

District Court, N. D. Iowa

United States Jaycees v.
Cedar Rapids Jaycees

No. C 82-176

Decided August 1, 1985

TRADEMARKS

1. Title — Licenses (§67.867)

Injunctive relief is not warranted in United States Jaycees' action to terminate licensee's use of trademark "Jaycees" solely because licensee admitted women as members, since government's interest in preventing invidious discrimination outweighs public interest in preventing trademark infringement and in preventing market confusion.

¹ *Houston Atlas, Inc. v. Del Mar Scientific Inc.*, 217 USPQ 1032 at 1037 (DC N.Tex. 1982).

² Manual of Patent Examining Procedure, 4th Ed., Aug. 1983, page 900-5, Section 901.05D(b), Unprinted Foreign Patents.

³ *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985) (at 4) states that "...only new or amended claims are also examined under 35 U.S.C. §§112 and 132, 37 CFR 1.552; MPEP §2258."

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